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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

<b>Application Number</b>	10/719,622		
	<b>Filing Date</b>	November 21, 2003	
	<b>First Named Inventor</b>	Moshe LEVNAT	
	<b>Group Art Unit</b>	2834	
	<b>Examiner Name</b>	Not yet assigned	
<b>Total Number of Pages in This Submission</b>	14	<b>Attorney Docket Number</b>	847-072

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition (Request for Reconsideration of Petition Under 37 CFR 1.47(b)) <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)  <b>Remarks</b>  <b>The Commissioner is authorized to charge any additional fees to Deposit Account No. 50-0289.</b>	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosures (please identify below): Copy of Decision Refusing Status Under 37 CFR 1.47(b) (2 pp.); Declaration for Utility Patent Application (2 pp.); Copy of 8/10/04 Email communication re inventor's last known address (1 p.); and Certificate of First Class Mailing.
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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Wall Marjama & Bilinski LLP Joseph B. Milstein	Reg. No. 42,897
Signature		
Date	August 12, 2004	

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: **August 12, 2004**

Typed or printed name	Sarah A. Lockwood		
Signature		Date	August 12, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Attorney Docket No.: 847-072

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of: Moshe Levnat.

Serial No.: 10/719,622

Group Art Unit: 2834

Filed: November 21, 2003

Examiner: Not yet assigned

TITLE: STAINLESS STEEL UNSEALED MOTOR

I hereby certify that this correspondence is being communicated by First Class Mail. Postage prepaid, to the United States Patent and Trademark Office at Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 12, 2004.

Sarah A. Lockwood

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF  
PETITION UNDER 37 CFR §1.47(b)**

The DECISION REFUSING STATUS UNDER 37 CFR §1.47(b) (hereinafter “the decision”) was mailed on July 14, 2004 from the Office of Petitions of the United States Patent and Trademark Office. This response is timely filed, and Applicant believes that no fees are due on account of the filing of this paper. However, if additional fees are required, the Director is authorized to deduct such fee from the undersigned’s Deposit Account No. 50-0289, or credit any overpayment to the same Deposit Account.

The decision cited three deficiencies:

- (1) an acceptable oath or declaration was lacking;
  - (2) a statement of the last known address of the non-signing inventor was omitted;
- and

(3) proof of proprietary interest was not given.

Applicant addresses each of the deficiencies below.

**An acceptable oath or declaration**

In response to the lack of an acceptable DECLARATION, enclosed herewith is a declaration signed by Joseph B. Milstein, USPTO Registration # 42,897, (instead of non-signing inventor Mr. Moshe Levnat) on behalf of and as agent for Cleveland Motion Controls, Inc. (hereinafter "CMC"), pursuant to authorization given by Mr. Richard Ryan, Vice President and Treasurer of Cleveland Motion Controls, Inc. in the attached copy of an email communication. CMC owns a division named CMC Torque Systems, having a place of business at 6 Enterprise Road, Billerica, Massachusetts 01821-5734 USA, where Mr. Levnat was employed during the relevant times. Applicant believes that this declaration is sufficient.

**A statement of the last known address of the non-signing inventor**

As indicated in the declaration, the last known address for Mr. Levnat is 5500 Fortunes Ridge 94B, Durham, NC 27713 USA.

**Proof of proprietary interest**

The undersigned has prepared the following Memorandum of Law in support of the claim that CMC is entitled to, and has, a proprietary interest in United States Patent Application Serial No. 10/719,622.

MEMORANDUM OF LAW

THE UNDERSIGNED IS AN ATTORNEY FAMILIAR WITH THE LAW OF THE JURISDICTION

The undersigned, Joseph B. Milstein, USPTO Registration # 42,897, is an attorney admitted to the practice of law in the Commonwealth of Massachusetts.

THE LAW OF THE JURISDICTION

The undersigned has read the opinion of the Massachusetts Supreme Judicial Court in *National Development Company v. Gray et al.*, 316 Mass. 240, 55 N.E.2d 783, 62 USPQ 205, 153 A.L.R. 973 (1944) (hereinafter “*National Development*”) and is familiar with its holding. *National Development* is the leading Massachusetts Supreme Judicial Court decision finding an employment relationship deemed to be one where the employee was obliged to assign in the absence of a written agreement. In *National Development*, the employee developed a new machine as part of his employment duties. The Massachusetts Supreme Judicial Court found that the employee was obliged to assign his invention to his employer because he was hired to develop and perfect the employer’s machine, even though he had not signed an agreement and even though he made the drawings at home on his own time during the term of his employment as an employee at will.

A copy of *National Development* as published in 62 USPQ was previously submitted with the PETITION. At 62 USPQ 209-210, the opinion states that the employee “had prepared a drawing which was sufficient to satisfy his own patent

attorney ... that it would not be an infringement of the plaintiff's machine ... It is plain from the evidence ... that the drawing was the nucleus from which the machine emerged ... .”

Furthermore, in *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998) 124 F.3d 1429, the Supreme Court of the United States more recently held that an invention is “ready for patenting” when “the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.”

The undersigned hereby asserts the following points of law:

1. The law of the Commonwealth of Massachusetts is the law of the jurisdiction in the present matter.
2. The Massachusetts Supreme Judicial Court (hereinafter “SJC”) is the highest court of competent jurisdiction organized under the Constitution of the Commonwealth of Massachusetts.
3. The holdings of the SJC are mandatory precedent for all courts of law organized under the Constitution of the Commonwealth of Massachusetts.
4. The holding of the SJC in *National Development* has not been overturned, to the best knowledge and belief of the undersigned.

THE FACTS RELATING TO THE PRESENT APPLICATION PARALLEL THOSE IN

NATIONAL DEVELOPMENT CO. V. GRAY ET AL.

The undersigned prepared and filed the declaration signed by E. Wayne Foley, President of Cleveland Motion Controls (hereinafter “CMC”), that was previously

submitted with the PETITION, and the undersigned is familiar with the facts asserted therein.

The facts asserted in Mr. Foley's declaration, and supported by attachments thereto, include:

- A. Mr. Levnat was employed by CMC in a facility located in Billerica, Massachusetts, pursuant to an offer letter and a position description;
- B. The position description stated that Mr. Levnat's duties included, among others, to "Perform electro-magnetic design and development of all Servo motors";
- C. During the course of his employment in the Billerica, Massachusetts facility, Mr. Levnat prepared a description of a stainless steel unsealed brushless motor, which description is entitled, "Grote stainless steel unsealed brushless motor proposal concept – 3/18/03";
- D. Mr. Levnat received a salary during the course of his employment in the Billerica, Massachusetts facility;
- E. Mr. Levnat left the employ of CMC some months after preparing the description of the stainless steel unsealed brushless motor;
- F. Mr. Levnat's attorney did not assert that Mr. Levnat's duties as an employee were other than as stated in the offer letter and position description, and actually argued that the position description was a correct statement of duties;
- G. The description of a stainless steel unsealed brushless motor prepared by Mr. Levnat served as the basis for the preparation of United States Patent Application Serial No. 10/719,622; and

In re the application of: Moshe Levnat.  
Serial No.: 10/719,622  
Filed: November 21, 2003  
Request for Reconsideration of Petition Under 37 CFR 1.47(b)

H. Mr. Levnat was presented with a copy of United States Patent Application Serial No. 10/719,622 and a Declaration therefor, and refused to sign said Declaration.

THE LAW APPLIED TO THE FACTS INDICATES THAT MR. LEVNAT  
IS OBLIGED TO ASSIGN THE APPLICATION TO PETITIONER CMC

The law in Massachusetts is that, in the absence of a signed agreement, an employee who performed the duties expected of him, as part of his employment, is obliged to assign to his employer any invention made as part of the performance of his agreed duties.

Mr. Levnat's employment at the relevant time was in Massachusetts.

Mr. Levnat did not sign an agreement regarding ownership or assignment of inventions.

Mr. Levnat received a salary as consideration for his work as an employee.

Mr. Levnat was hired to "Perform electro-magnetic design and development of all Servo motors" and the Grote design of March 2003 was prepared as part of his agreed-upon duties.

It is the opinion of the undersigned that a court of competent jurisdiction obliged to apply the law of the Commonwealth of Massachusetts as expressed in *National Development Company v. Gray et al.* would find that Mr. Levnat is obliged to assign the rights to the invention or inventions described in United States Patent Application Serial No. 10/719,622 to his employer, CMC, because the facts of this matter parallel those of *National Development Company v. Gray et al.*

### CONCLUSION

CMC respectfully requests reconsideration of the previously filed **PETITION** to the Director of the United States Patent and Trademark Office to grant it standing to prosecute through its undersigned representative the above identified patent application, and to have issued in its name any and all Letters Patent that may issue from the present application, and from any continuations, continuations-in-part, divisionals or other applications claiming the priority and the benefit of the present application.

The undersigned believes that all formalities within the control of CMC have been attended to, and a positive determination with respect to the reconsideration of the previously filed **PETITION** on the part of the Director is respectfully requested at the earliest possible time, so that this application can be examined on the merits.

Respectfully submitted,



Joseph B. Milstein, Ph.D.  
Registration No. 42,897

Date: August 12, 2004

Wall Marjama & Bilinski LLP  
Customer No. 20874  
Telephone: (315) 425-9000  
Facsimile: (315) 425-9114





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WALL MARJAMA & BILINSKI LLP

WALL MARJAMA & BILINSKI  
101 SOUTH SALINA STREET  
SUITE 400  
SYRACUSE, NY 13202

COPY MAILED

JUL 14 2004

OFFICE OF PETITIONS

In re Application of :  
Levnat : DECISION REFUSING STATUS  
Application No. 10/719,622 : UNDER 37 CFR 1.47(b)  
Filed: November 21, 2003 :  
Atty. Dkt. No.: 847-072 :  
For: STAINLESS STEEL UNSEALED :  
MOTOR :

This decision is in response to the petition under 37 CFR 1.47(b),  
filed May 28, 2004.

The petition is DISMISSED.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a). (P)

The above-identified application was filed November 21, 2003 without an executed oath or declaration and naming Moshe Levnat as sole inventor. Accordingly, a Notice to File Missing Parts of Nonprovisional Application was mailed March 8, 2004. Petitioner responded with the instant petition on May 28, 2004. The response lacked the required declaration. Hence, a Notice of Incomplete Reply was mailed April 14, 2004. There is no indication in the official application file that a response to the Notice of Incomplete Reply has been filed.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115

and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

The instant petition lacks items (2), (4), and (5).

The instant petition lacks item (2) set forth above. An acceptable oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. Any renewed petition must be accompanied by an oath or declaration in accordance with 37 CFR 1.63 and 1.64. The declaration should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer of the assignee on behalf of and as agent for the non-signing inventor. The corporate officer's title or position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. The signature block of the non-signing inventor should remain unexecuted. Petitioner's attention is directed to MPEP 409.03(b) for further guidance.

As to item (4), the petition lacks a statement setting forth the last known address of the inventor. Any renewed petition should include a short statement setting forth the last known legal address of the inventor.

As to item (5), petitioner has presented no evidence of proprietary interest in the above-referenced application. Any renewed petition must establish that the invention has been assigned to applicant, that the inventor has agreed in writing to assign the invention to an applicant, or that an applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Petitioner must submit a copy of employment agreement between the inventor and an applicant or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by weight of authority in that jurisdiction award title of the invention to a Rule 47 applicant.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450

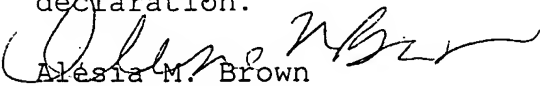
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306

By hand: U.S. Patent and Trademark Office  
220 20<sup>th</sup> Street S.  
Customer Window  
Crystal Plaza 2, Lobby, Room 1B03  
Arlington, VA 22202

By delivery service: U.S. Patent and Trademark Office  
(FedEx, UPS, DHL, etc.) 2011 South Clark Place  
Customer Window, Mail Stop Petition  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Petitioner is encouraged to contact the undersigned at (703) 305-0310 for any clarification regarding the submission of a proper declaration.

  
Alesia M. Brown  
Petitions Attorney  
Office of Petitions



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**DECLARATION FOR UTILITY OR  
DESIGN  
PATENT APPLICATION  
(37 CFR 1.63)**Declaration  
Submitted  
With Initial  
Filing

OR

Declaration  
Submitted after Initial  
Filing (surcharge  
(37 CFR 1.16 (e))  
required)

Attorney Docket Number	847-072
First Named Inventor	Moshe Levnat
COMPLETE IF KNOWN	
Application Number	10/719,622
Filing Date	November 21, 2003
Art Unit	
Examiner Name	

**I hereby declare that:**

Each inventor's residence, mailing address, and citizenship are as stated below next to their name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

STAINLESS STEEL UNSEALED MOTOR

(Title of the Invention)

the specification of which



is attached hereto

OR



was filed on (MM/DD/YYYY)

11/21/2003

as United States Application Number or PCT International

Application Number

10/719,622

and was amended on (MM/DD/YYYY)

(if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				Yes	No
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

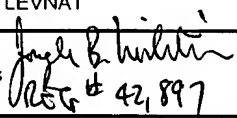
[Page 1 of 2]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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**DECLARATION — Utility or Design Patent Application**

Direct all correspondence to: <input checked="" type="checkbox"/> Customer Number: <span style="border: 1px solid black; padding: 2px 20px;">20874</span> <b>OR</b> <input type="checkbox"/> Correspondence address below			
Name			
Address			
City		State	ZIP
Country	Telephone	Fax	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.			
NAME OF SOLE OR FIRST INVENTOR:		<input checked="" type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any]) Moshe		Family Name or Surname LEVNAT	
Inventor's Signature Joseph B. Milstein, on behalf of and as agent for Cleveland Motion Controls		 # 42,897	Date August 10, 2004
Residence: City Durham	State NC	Country USA	Citizenship USA
Mailing Address 5500 Fortunes Ridge 94B			
City Durham	State NC	ZIP 27713	Country USA
NAME OF SECOND INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	ZIP	Country
<input type="checkbox"/> Additional inventors or a legal representative are being named on the supplemental sheet(s) PTO/SB/02A or 02LR attached hereto.			



RE: Information required for response to USPTO in Levnat Application

Page 1 of 2

**Joseph Milstein**

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**From:** BU: Cynthia Locklear [CynthiaLocklear@IMCUSA.com]

**Sent:** Tuesday, August 10, 2004 3:19 PM

**To:** 'Joseph Milstein'

**Subject:** RE: Information required for response to USPTO in Levnat Application

Dear Joe;

In consultation with Richard Ryan, the Vice President and Treasurer of Cleveland Motion Controls, Inc., be advised that you are authorized to sign a declaration on behalf of CMC in place of Mr. Levnat.

Mr. Levnat's last known residence address is: 5500 Fortunes Ridge 94B, Durham, NC 27713.

Should you require any further information, please dont hesitate to contact me.

Best regards,

Cynthia Locklear

CMC: Assistant Secretary

IMC: Corporate Counsel and Assistant Secretary